

### **REMARKS**

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Office Action dated July 20, 2006 (U.S. Patent Office Paper No. 20060715). In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

#### **Status of the Claims**

As outlined above, claims 1-4, 6-18 and 23-32 stand for consideration in this application, wherein claims 5 and 7 are being canceled without prejudice or disclaimer, while claim 1 is being amended to correct formal errors and to more particularly point out and distinctly claim the subject invention. Claims 20-22 stand withdrawn from consideration in this application.

All amendments to the application are fully supported therein, including . . . . Applicant hereby submits that no new matter is being introduced into the application through the submission of this response.

#### **Formal Objections**

Claim 7 was objected to, as being of improper dependent form for failing to further limit the subject matter of previous claim 1.

As set forth, claim 7 is being canceled, and therefore withdrawal of this objection is respectfully requested.

#### **Prior Art Rejections**

##### **The First 35 U.S.C. §102(b) or 103(a) rejection**

Claims 1-4, 6-18 and 23-32 were rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over Sato et al (US 4,734,323). Applicants respectfully traverse this rejection for the reasons set forth below.

According to the M.P.E.P. §2131, a claim is anticipated under 35 U.S.C. §102 (a), (b), and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

With respect to 35 U.S.C. §103 (a) rejection, the Manual of Patent Examining Procedure (M.P.E.P. §2143) sets forth,

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both not found in the prior art, not in the applicant's disclosure.

#### Claim 1

The Office Action contends that Sato discloses a laminate structure comprising a panel surface 1 (hard metal plate), an adhesive 20, a retainer layer 21 and a form layer 23, and the vibration damping layer 7 and the sound proof layer 8 were attached, set to the panel surface of a vehicle and then heated to form the vibration damping layer and the porous soundproof layer respectively. The Office Action further contends that Sato's laminate structure comprises a foam layer/ non-form layer/hard plate and is unpatentable over Sato on the ground that if the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

Furthermore, in the Examiner's response to Applicants' arguments made in a response dated March 20, the Examiner alleges that Sato shows that the three layers have been laminated to one another prior to the metal plate 9 being formed to a desired shape.

The Applicants respectfully disagree. In one hand, the Examiner alleges that a hard metal plate recited in claim 1 reads on a panel surface 1. On the other hand, the Examiner alleges that a hard metal plate recited in claim 1 reads on a resonance absorption plate layer forming material 9. The resonance absorption plate layer forming material 9 is different part from the panel plate. The resonance absorption plate layer 9 does not correspond to the hard metal plate recited in claim 1.

Claim 1 recites that a resin laminate sound insulation board which is a laminated plate, comprises: a foamable resin foamed at a foaming temperature by heating; a shape-formable hard metal plate; and a non-foamable material laminated between said foamable resin and said hard plate, wherein said foamable resin and said non-foamable material are adhered to each other and said non-foamable material are adhered to said hard plate prior to

heating and prior to said hard plate being formed to a desired shape, and said foamable resin is heated to a foamed state having a thickness that enhances a rigidity of at least said shaped hard plate.

A formable hard metal plate which is to be formed to a desired shape is one of the elements of the resin laminate sound insulation board recited in claim 1. Because the foamable resin and non-foamable material to which the formable resin is adhered is adhered to a pre-formed metal hard plate, thickness of the unheated foamable resin can remain thin, and therefore the total thickness of the board can remain thin. Consequently, there is little restriction in the shape of the board to be formed, the place to which the board is to be arranged or the weight of the board, even though the foamable resin and non-foamable material are adhered to the hard metal plate. This functional feature is achieved by the board prepared in accordance with claim 1.

In contrast, Sato is directed to a sheet which renders the surface of a soundproof layer irrespective of the uneven configuration of a panel surface of a vehicle. (col. 2, lines 19-30) Sato merely shows in Figs. 6 and 7 that a laminate comprising a sound-proof layer material and a damping layer is placed on an already formed panel surface/plate. Sato does not show that the panel surface/plate is further formed to a desired shape after the laminate is placed on the panel surface/plate. Sato's claiming only a laminate portion evidences that Sato does not teach that a hard metal plate can be shaped while layers of a foamable resin and a non-foamable material are adhered to the hard metal plate.

Therefore, Sato does not show every element recited in claim 1. Accordingly, claim 1 is not anticipated by Sato.

Again, Sato's claiming only a reinforcement laminate portion would indicate that there is no suggestion or motivation to create a resin laminate sound insulation board including the hard metal plate which can be formed to a desired shape. Accordingly, claim 1 is not obvious in view of all the prior art.

## Claim 2

Claim 2 has the substantially same features as those of claim 1. As such, the arguments set forth above are equally applicable here. Claim 1 being allowable, claim 2 must also be allowable.

#### Claims 3-4, 6-18, 23-32

As to dependent claims 3-4, 6-18, and 23-32, the arguments set forth above with respect to independent claims 1 and 2 are equally applicable here. The base claim being allowable, claims 3-4, 6-18, and 23-32 must also be allowable.

#### The Second 35 U.S.C. §102(e) or 103(a) rejection

Claims 1-4, 6-18 and 23-32 were rejected under 35 U.S.C. §102(e) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over Wycech (US 6,372,334). Applicants respectfully traverse this rejection for the reasons set forth below.

#### Claim 1

The Office Action contends that Wycech discloses a laminate structure comprising a metal substrate, a compliant foam layer, a rigid foam layer and a backing film layer and that a first foamable resin and a second foamable resin are adhered to a hard plate prior to heating. The Office Action further contends that Wycech's laminate structure comprises a foam layer/form layer/hard plate and is unpatentable over Wycech on the ground that if the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Applicants respectfully disagree.

Wycech merely shows a reinforcement laminate comprising two compliant foam layers, and placed on an already-formed metal substrate. Furthermore, as with Sato, Wycech does not show that the panel surface/plate is further formed to a desired shape after the laminate is placed on the panel surface/plate. Wycech's showing only a laminate portion evidences that Wycech does not teach that a hard metal plate can be shaped while layers of a foamable resin and a non-foamable material are adhered to the hard metal plate.

#### Claim 2

Claim 2 has the substantially same features as those of claim 1. As such, the arguments set forth above are equally applicable here. Claim 1 being allowable, claim 2 must also be allowable.

Claims 3-4, 6-18, 23-32

As to dependent claims 3-4, 6-18, and 23-32, the arguments set forth above with respect to independent claims 1 and 2 are equally applicable here. The base claim being allowable, claims 3-4, 6-18, and 23-32 must also be allowable.

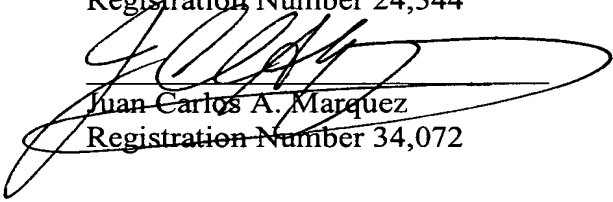
Conclusion

In view of all the above, Applicants respectfully submit that certain clear and distinct differences as discussed exist between the present invention as now claimed and the prior art references upon which the rejections in the Office Action rely. These differences are more than sufficient that the present invention as now claimed would not have been anticipated nor rendered obvious given the prior art. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application as amended is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicant's undersigned representative at the address and phone number indicated below.

Respectfully submitted,

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